

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte NORBERT C. VOLLMANN

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Appeal No. 96-2686  
Application 08/224,213<sup>1</sup>

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ON BRIEF

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Before HAIRSTON, JERRY SMITH and LALL, Administrative Patent Judges.

LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 5, all the outstanding claims in the case<sup>2</sup>.

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<sup>1</sup> Application for patent filed April 7, 1994.

<sup>2</sup> There was an amendment after the final, filed on August 25, 1995, and was entered in the record.

The disclosed invention relates to an arrangement of a magnetic head and the printed circuit cable in a cassette recorder. The cable is coiled in cylindrical form around the pivot axis of the head. The head has a translational motion along the pivot axis, and also can pivot about the pivot axis as the head is engaged with, and disengaged from the tape. The arrangement of the invention facilitates for a shorter cable and the ease of assembly of the components of the recorder to provide for both the pivotal and the translational movement of the head.

Representative claim 1 is reproduced as follows:

1. A magnetic cassette recorder comprising a magnetic head which can be translated between an operating position, in which the head cooperates with a magnetic tape in an inserted cassette, and a withdrawn position, in which the head is clear of an inserted cassette, and which is, moreover, pivotable about a pivot axis between a first angular position and a second angular position, which head is electrically connected to stationary parts of the recorder by means of a flat flexible multiple electrical conductor, such as a foil carrying printed electrical conductor tracks or a flat cable, characterized in that the conductor is arranged as a cylindrical spiral about the pivotal axis and its end which is remote from the head is connected directly to the stationary parts of the recorder, so that translations of the head in the axial direction result in the spiral being extended/compressed and pivotal movements of the head result in the spiral being coiled/uncoiled.

The references relied on by the examiner are:

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Herleth et al.(Herleth)	3,949,421	Apr. 6, 1976
Oguchi et al.(Oguchi)	4,945,437	Jul. 31, 1990

Claims 1 through 5 stand rejected under 35 U.S.C. § 103.  
As evidence of obviousness, the examiner offers Herleth and  
Oguchi [answer, page 2].

Reference is made to Appellant's brief, reply brief, and  
the examiner's answer for their respective positions.

#### **OPINION**

We have carefully considered the entire record before us,  
and we will reverse the obviousness rejection of claims 1  
through 5.

With respect to independent claim 1, the Examiner takes  
the position that Oguchi discloses the claimed arrangement  
except that Oguchi does not show a translational movement of  
the magnetic head 10. The Examiner uses Herleth to show the  
translational movement of a magnetic head, item 5 in figure 2.  
The Examiner asserts that it would have been obvious, to one  
of ordinary skill in the art at the time of the invention, to  
arrange the [magnetic] head of Oguchi to be moveable along the  
pivot axis, as it was well known to do so, for the purposes of

controlling the contact with the tape and for loading and unloading the cassette, as evidenced by Herleth [answer, page 3].

Appellant first argued that Oguchi did not show a cable wound around a pivot axis in cylindrical form [brief, page 5], but later yielded to the Examiner's argument on this point [reply brief, page 1]. Still remaining is the argument by Appellant that there is no translational movement of the head in Oguchi. Further, he asserts that Herleth shows the to and from movement of the slide 6, carrying the head 5, in relation to the tape, but does not show the pivoting motion of the head and that Herleth does not at all disclose the printed cable or other electrical connections. Appellant concludes that clearly there is nothing in the teachings of Oguchi or Herleth that would lead one of ordinary skill in the art to combine the pivotal and translatory movements of the magnetic heads of these two patents. Also, for the same reason, he asserts that such a combination would not yield an electrical connection between a magnetic head and a stationary part of the recorder by a flat flexible electrical conductor [cable] arranged as a cylindrical spiral around a transitory [translatory] axis

[brief, pages 5 to 6].

The examiner responds that it was extremely well known in the art to enable the head to translate between an operable position and a withdrawn position so as to control contact between the magnetic head and the magnetic tape contained in the cassette. The Examiner contends that Herleth was cited as evidence of such notoriety [answer, pages 5 to 6].

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (CCPA 1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044,

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1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

As indicated by the cases just cited, the examiner has at least two responsibilities in setting forth a rejection under 35 U.S.C. § 103. First, the examiner must identify all the differences between the claimed invention and the teachings of the prior art. Second, the examiner must explain why the identified differences would have been the result of an obvious modification of the prior art.

In our view, the examiner has properly addressed his first responsibility, but has not met his second responsibility.

We agree with Appellant that the Examiner's suggested combination of Oguchi and Herleth is not justified.

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The structure of Oguchi which controls the movement of the magnetic head 10 is very different from the slide 6 carrying head 5 in Herleth. If one were to incorporate translatory movement of Herleth into Oguchi's mechanism having head 10, one would have to destroy the disclosed operation of Oguchi's mechanism and redesign same to meet the invention of claim 1. This would be tantamount to a reconstruction of a prior art device using the teachings of the claimed invention. That is not the test of obviousness. Therefore, the Examiner has not established a prima facie case of obviousness in his rejection.

Thus the collective teachings of Oguchi and Herleth do not support the rejection proposed by the examiner to reject claim 1. Since claims 2 through 5 depend on claim 1, and also grouped together with claim 1 in the brief [page 4], the above evidence does not support the Examiner's rejection as to them.

#### **DECISION**

The decision of the examiner rejecting claims 1 through 5 under 35 U.S.C. § 103 is reversed.

#### **REVERSED**

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KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
	)	
	)	
JERRY SMITH	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
PARSHOTAM S. LALL	)	
Administrative Patent Judge	)	



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